



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/650,603	08/28/2003	David H. Burkett	ACS 65356 (1747D)	8329
24201 7590 03/03/2009 FULWIDER PATTON LLP HOWARD HUGHES CENTER 6060 CENTER DRIVE, TENTH FLOOR LOS ANGELES, CA 90045				
EXAMINER				
HONG, JOHN C				
ART UNIT		PAPER NUMBER		
3726				
MAIL DATE		DELIVERY MODE		
03/03/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/650,603

Applicant(s)

BURKETT, DAVID H.

Examiner

JOHN C. HONG

Art Unit

3726

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15, 18 and 19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15, 18, 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/5508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. In view of the Appeal Brief filed on 6/3/08, PROSECUTION IS HEREBY REOPENED.

A new non-final Office Action is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/DAVID P. BRYANT/
Supervisory Patent Examiner, Art Unit 3726

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claim 19** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 19, line 11, "the flexible body" lacks antecedent basis.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,5,6,9,12 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by JP09206382.

Regarding Claims 1 and 5-6, '382 discloses a process for forming a guide wire for use in a medical procedure, comprising: forming a male end (13) at an extremity of a first elongated member (2) formed of a first continuous material; forming a female end (3) at an extremity of a second elongated member (1), the second elongated member and the female end being formed of a second continuous material; and permanently securing (crimping; [0005] of translation) the male end of the first elongated member within the female end of the second elongated member (Fig. 3(A)) ; and the 1st and 2nd continuous material comprises of stainless steel and Nitinol (Titanium Nickel Alloy) ([0017] of translation).

Regarding Claim(s) 9,12,13, '382 discloses a guide wire for use in a medical procedure, comprising: a first elongated member (2) having an extremity and a male end (13) formed at the extremity, the first elongated member (2) formed of a first continuous material; a second elongated member (1) including a second extremity, the second extremity of the second elongated member including a female end (3), the second elongated member and the female end being formed of a second continuous material; wherein the male end is permanently secured (crimping; [0005] of translation) within the female end of a second elongated member (Fig.

3(A)); and the 1st and 2nd continuous material comprises of stainless steel and Nitinol (Titanium Nickel Alloy) ([0017] of translation).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2,3,10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP09206382 in view of Matsutani (U.S. Patent 4501312).

Regarding Claim(s) 2 and 10, ‘382 teaches the limitations except the female end is formed by electrical discharge machining.

Matsutani teaches forming a female end in a needle by forming a hole by electrical discharge machining (Col. 5, line 42 and 43).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to employ the step of forming the female end by electrical discharge machining, as taught by Matsutani on the method of ‘382 so as to produce a hole in the female end effectively.

Regarding Claim(s) 3 and 11, ‘382 teaches the limitations except the female end is formed by laser drilling.

Matsutani teaches forming a female end in a needle by forming a hole by laser drilling (Col. 5, lines 42 and 43).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to employ the step of forming female end by laser drilling as taught by Matsutani on the method of '382 so as to produce a hole in the female end effectively.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP09206382 in view of AAPA (Applicant's Admitted Prior Art) .

Regarding Claim(s) 4, '382 teaches the limitations except the first continuous material is different from the second continuous material.

AAPA as disclosed in the specification ([0001] lines 4-6) teaches the first continuous material is different from the second continuous material.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to make the first continuous material is different from the second continuous material, as taught by AAPA, on the method of '382 so as to impart distinct handling characteristics to each wire element.

Claims 7, 14, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP09206382 in view of Abrams et al. (U.S. Patent 7258753).

Regarding claims 7 and 14, '382 teaches all limitations except the step of securing the male end to the female end is selected from the group consisting of soldering, welding and gluing.

Abrams et al. teach the step of securing the male end to the female end is selected from the group consisting of soldering, welding and gluing (Col. 6, lines 37-40).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to employ the step of securing the male end to the female end is selected from the

group consisting of soldering, welding and gluing, as taught by Abrams et al. on the method of '382 so as to firmly secure the male and female parts together.

Regarding Claim(s) 18, '382 teaches a guide wire, comprising: an elongated proximal core portion having a female end (3) disposed at the distal extremity, the proximal core portion and female end formed from a first continuous material; a distal core portion having a male end (13) disposed at the proximal extremity; wherein the male end is permanently secured (crimping; [0005] of translation) within the female end and the flexible body member is disposed about and secured to the distal core portion(Fig. 3(A)).

'382 fails to teach a flexible body member.

Abrams et al. teach a flexible body member (22) (Fig.1).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to employ the teachings of Abrams et al. on the method of '382 so as to impart distinct handling characteristics to each wire element.

Regarding Claim(s) 19, '382 teaches a process for constructing a guide wire comprising: providing an elongated proximal core portion including a distal extremity and having a male end (13) disposed at the distal extremity, the proximal core portion being formed from a first continuous material; providing a distal core portion including a proximal extremity and having a female end (3) with a predetermined depth disposed at the proximal extremity, the distal core portion and female end being formed from a second continuous material; permanently securing (crimping; [0005] of translation) the male end within the female end.

'382 fails to teach the proximal core portion being formed from a first continuous material including stainless steel, and the female end being formed from a second continuous

material including a nickel-titanium alloy; and disposing the flexible body member about the distal core portion.

Abrams et al. teach the proximal core portion being formed from a first continuous material including stainless steel (Col. 7 line 67-Col. 8, line 1), and the female end (42) being formed from a second continuous material including a nickel-titanium alloy (Col. 7, lines 41-44); and disposing the flexible body member (22) about the distal core portion (Fig. 1).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to employ the teachings of Abrams et al. on the method of '382 so as to impart distinct handling characteristics to each wire element.

Claims 8 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP09206382 in view of Imai et al. (U.S. Patent 5766059).

'382 teaches the limitations except the step of forming the male end comprises plunge grinding.

Imai et al. teach the step of forming a male end on a workpiece by plunge grinding (Col. 4, line 19).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to employ step of forming the male end comprises plunge grinding, as taught by Imai et al. on the method of '382 so as to form the male end without bending of the end part.

Response to Arguments

Applicant's arguments with respect to claims 1-15, 18 and 19 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN C. HONG whose telephone number is 571-272-4529. The examiner can normally be reached on M-F 9:00-17:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, DAVID BRYANT can be reached on 571-272-4526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JOHN C HONG/
Primary Examiner, Art Unit 3726

Jh
2/1/09